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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,228	06/30/2000	Luigi Forlai	07704.0006	2813
22852	7590	10/19/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/609,228

**Applicant(s)**

FORLAI, LUIGI

**Examiner**

Narayanswamy Subramanian

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,6,17 and 20-46 is/are pending in the application.
- 4a) Of the above claim(s) 34-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 6, 17, 20-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to communication from the Applicants dated June 30, 2004. Amendments to claims 20-25, addition of new claims 26-46 and cancellation of claims 1, 3-5, 7-16, 18 and 19 have been entered. Claims 2, 6, 17 and 20-46 are currently pending in the application. Claims 34-46 withdrawn from consideration for reasons given below. Claims 2, 6, 17, 20-28, 32 and 33 have been examined. The response to amendment, rejections and response to arguments are stated below.

#### ***Response to Amendment***

2. Newly submitted claims 34-46 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

I. Original and amended claims 2, 6, 17, 20-28, 32 and 33 are drawn to a method for using an electronic network system to facilitate a transaction between a seller and a buyer including the steps of inputting a sale offer parameter for randomly generating at least one sale offer to purchase a product or service, classified in class 705, subclass 37.

II. Claims 34-46 are drawn to methods of using an electronic network system to facilitate a transaction between a donor or a seller and a recipient including the steps of providing an opportunity for the selected recipient to accept the at least one randomly displayed offer within a limited duration of time and receiving an indication of acceptance of the randomly displayed offer from the selected recipient on the electronic network system, classified in class 705, subclass 37.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are

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shown to be separately usable. In the instant case, invention I relates to a method for using an electronic network system to facilitate a transaction between a seller and a buyer including the steps of inputting a sale offer parameter for randomly generating at least one sale offer to purchase a product or service, whereas invention II relates to methods of using an electronic network system to facilitate a transaction between a donor or a seller and a recipient including the steps of providing an opportunity for the selected recipient to accept the at least one randomly displayed offer within a limited duration of time and receiving an indication of acceptance of the randomly displayed offer from the selected recipient on the electronic network system. Clearly the step present in one method is not present in the other making the two methods distinct and different. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. Since applicant has received an action on the merits for the originally presented claims, these claims have been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 34-46 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Applicants in replying to this office action are respectfully advised to cancel the non-elected claims.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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6. Claims 20-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 recites the limitations "said program" and "said browser". There is no antecedent basis for these limitations. Also claims 21-25 are rejected because they are dependent on the rejected claim 20. The meaning of the features in these claims is not clear to the Examiner, and hence the examiner is unable to provide an art rejection for these claims.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 2, 6 and 17 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Odom et al (US Patent 6,058,379).

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With reference to claim 2, Odom teaches a method for using an electronic network system to facilitate a transaction between a seller and a buyer, said method comprising the steps of: inputting a sale offer parameter for randomly generating at least one sale offer to purchase a product or service (See Odom Column 3 lines 20-26); randomly displaying, through the electronic network system, the at least one sale offer to a selected buyer at an unexpected period of time (See Odom Column 3 lines 20-26 and Column 5 lines 46-50); and withdrawing the display of the randomly generated sale offer in response to an absence of an indication of acceptance of the randomly generated sale offer by the buyer within a predetermined period of time after the step of displaying the randomly generated sale offer (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67). Posting information on the Web and sending e-mail to notify implies displaying at an unexpected period of time.

With reference to claim 6, Odom teaches a method of making a sale offer from a seller to at least one buyer visiting a Internet web site, comprising the steps of: displaying, on the web site, a sale offer of a product or service to the at least one selected buyer at a random point in time unknown to the buyer (See Odom Column 3 lines 20-26 and Column 5 lines 46-50); and withdrawing the displayed sale offer from the Internet website when the at least one buyer does not indicate acceptance of the sale offer within a predetermined period of time (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67). Posting information on the Web and sending e-mail to notify implies displaying at a random point in time unknown to the buyer.

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With reference to claim 17, Odom teaches a method of claim 2, wherein the at least one sale offer is randomly displayed to a selected buyer only on condition that said buyer is connected to a portion of the electronic network system which is linked to the seller (See Odom Column 3 lines 20-28 and Column 5 lines 34-37) Accessing the listing information by the buyer and electronic chat implies the buyer being connected to a portion of the electronic network system which is linked to the seller.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom et al (US Patent 6,058,379)

With reference to claims 32 and 33, Odom teaches a method of claim 2 as discussed above further comprising the steps of receiving, through the electronic network system, a first indication of acceptance from the buyer in response to the display of the at least one randomly generated sale offer; displaying at least one term associated with the at least one randomly generated sale offer in response to the first indication of acceptance; receiving a second indication of acceptance from the buyer in response to the display of the at least one term associated with the at least one randomly generated sale offer (See Odom Column 6 lines 28-33 and lines 52-58); displaying at least one payment

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method option in response to the indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method option; transferring a sum corresponding to the selected payment method from the buyer to the seller; and requesting delivery of the offered product or service to the buyer (See Odom Column 3 lines 43-46). The best bids are displayed to the bidders and the window for making a bid implies opportunities to make repeated bids within a predetermined time. The Clearing process and mechanisms are interpreted to include the steps of displaying at least one payment method option in response to the indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method option; transferring a sum corresponding to the selected payment method from the buyer to the seller; and requesting delivery of the offered product or service to the buyer. Alternatively these steps are old and well known in the art. These steps help in the speedy and smooth conclusion of the transaction. Odom also teaches the step wherein an offer price substantially equal to a delivery price associated with the sale offer transaction (See Odom Column 2 lines 7-8). Since the seller sets the selling price, it can be any price including a delivery price.

Odom does not explicitly teach the steps of displaying an acceptance form and receiving a completed acceptance form.

Official notice is taken that these steps are old and well known in the art. These steps provide for smooth negotiations between the parties involved in the transaction.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine these steps to the disclosure of Odom. The combination of



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the disclosures taken as a whole, suggests that both parties to the transaction would have benefited from the smooth negotiations as a result of inclusion these steps.

10. Claims 26-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom et al (US Patent 6,058,379) in view of Smith (US Patent 6,502,076 B1).

With reference to claims 26-31, Odom teaches methods of claims 2 and 6 as discussed above including the steps of displaying the at least one sale offer to the selected buyer over a predetermined period of time determined by the seller and unknown to the selected buyer (See Odom Column 5 lines 34-38, seller intervention implies the ability of the seller to display one sale offer to the selected buyer over a predetermined period of time determined by the seller and unknown to the selected buyer); displaying the at least one sale offer to a single potential buyer selected from a plurality of different potential buyers (See Odom Column 5 lines 47-51, sending E-mail to potential purchasers includes displaying the at least one sale offer to a single potential buyer selected from a plurality of different potential buyers).

Odom does not explicitly teach the step of providing a device for displaying contents to a user in a random manner.

Smith teaches the step of providing a device for displaying contents to a user in a random manner (See Smith Column 6 lines 46-54, Column 17 lines 17-20).

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the disclosure of Smith to the invention of Odom. The combination of the disclosures taken as a whole, suggests that sellers would have benefited from being able to target different buyers by randomly varying the times when the products are offered.

*Response to Arguments*

11. With respect to Applicant's arguments that Odom fails to teach the steps of inputting a sale offer parameter and randomly displaying the offer, the Examiner disagrees. Odom discloses the mode of operations of the exchange including specifying the rules and terms and ability to list items, modify/remove items, intervene in an exchange (See Odom Column 5 lines 22-24, 33-38). These clearly include the step of inputting a sale offer parameter. Sending E-mail to potential purchasers (See Odom Column 5 lines 47-51) implies randomly displaying the offer. Similarly other features listed in the independent claims are disclosed by Odom. Hence Odom clearly anticipates the Applicant's claimed invention.

Applicant's other remarks have been considered but are not persuasive.

*Conclusion*

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian  
October 14, 2004

 10/14/04  
Jagdish N. Patel  
Primary Examiner